

However, the Examiner contends that Mostafazadeh discloses these features and that Luvini discloses mini-cards. The Examiner concludes that one of ordinary skill would have been motivated to combine the teachings of these references because it would provide protection for the device of Hata within the more compact package of a mini-card.

Applicant urges that one of ordinary skill would not have been realistically motivated to combine the references as suggested by the Examiner and furthermore, even if combined, the references do not disclose or suggest every feature recited in claims 1-5.

Claims 1 and 4 require a plurality of individual substrates arranged in an array and that each substrate is covered with a respective case. In direct contrast, Hata teaches a single, very large substrate that can accommodate multiple circuits (see, for example FIG. 9A). The figures in Hata such as 7B, 9B and 13B are merely partial views of this single substrate in order to show finer detail. Thus, Hata teaches a single substrate (1) which is covered by a uniform coating of resin (6). Hata, therefore, does not disclose the individual substrates recited in claims 1 and 4 which are covered with a respective case. As neither Mostafazadeh nor Luvini disclose the recited individual substrates in an array, the combination of these references does not provide the requisite factual basis to support a prima facie case of obviousness under 35 USC §103. Withdrawal

and reconsideration of the rejection under 35 USC §103 of claims 1-4 is respectfully requested.

Independent of the above arguments, Applicants urge that one of ordinary skill would not have been motivated to combine the teachings of Mostafazadeh and Hata as suggested by the Examiner. In particular, Mostafazadeh discloses that encapsulating an integrated circuit (as shown in FIG. 1) is an undesirable goal. At column 1, line 66 - column 2, line 10, Mostafazadeh explicitly teaches away from enclosing a circuit in a case for thermal reasons (see also, column 1, lines 42-45). Thus, one of ordinary skill would not have been realistically motivated to ignore the warnings, and explicit teachings, of Mostafazadeh to modify the devices of Hata to have top and bottom case segments. In addition, the devices of Hata are surface mounted ICs. In FIG. 8, for example, the bottom portion of lead (2a) must be left uncovered to connect to whatever circuit board the substrate (1a) is mounted on. Encapsulating these leads of Hata with top and bottom case segments (as purportedly taught by Mostafazadeh) would render the device of Hata unsuitable for its purpose and make it ineffective. Thus, one of ordinary skill would not have been realistically motivated to combine the teachings of Hata and Mostafazadeh as suggested by the Examiner. Without the requisite motivation, a prima facie case of obviousness under 35 USC §103 cannot be established and Applicant, therefore, respectfully requests reconsideration and withdrawal of any rejection under 35 USC §103 which is predicated, wholly or in part, upon the combination of Mostafazadeh and Hata.

Claim 5 requires that a case cover the substrate and that a part of the substrate is exposed from an external side of the case. Applicant urges that neither Hata, Mostafazadeh, nor Luvini disclose or suggest these claim features. An example of the devices of Hata is shown in FIG. 8; the other embodiments are substantially similar. As can be seen from FIG. 8, the resin (6) or "case" sits on top of substrate (1a). There is no portion of the substrate which is exposed from a side of this case (6); more particularly, the sides of the case (6) are well above the substrate (1a) and it is physically impossible for an aperture or opening in the side of the case (6) to effect exposure of the substrate (1a). Neither Mostafazadeh nor Luvini disclose or suggest exposure of the substrate from the side of the case, as recited in claim 5, and, therefore, the combination of these references does not provide the requisite factual basis to establish a prima facie case of obviousness under 35 USC §103. Reconsideration and withdrawal of the rejection under 35 USC §103 of claim 5 is respectfully requested.

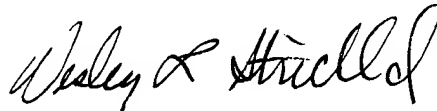
SUMMARY

In view of the above remarks, Applicant believes that claims 1-5 are in condition for allowance and passage of this case to issue is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

A handwritten signature in black ink, appearing to read "Wesley L. Strickland". The signature is fluid and cursive, with the first name "Wesley" and last name "Strickland" clearly distinguishable.

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